

REMARKS

Claims 1 and 3-13 are pending. Claims 3-12 are withdrawn.

Claims 1 and 2 are rejected under 35 USC 101 for “same invention” type double patenting over claims 1 and 2 of prior USP 7,395,944 and over claims 1 – 3 prior USP 7,228,988.

INTERVIEW SUMMARY Applicant’s attorney Gordon Coplein, Registration 19,165 conducted a telephone conversation with the Examiner on November 18, 2009 during which said attorney attempted to schedule an interview to discuss the outstanding rejection. The examiner said that an interview was not proper at this time and stated that a formal response should be made which would be promptly considered. Applicant so proceeds.

The claims at issue of the two patents are reproduced below. The application claims, and are presented above.

Claims of patent 7,395,944 ('944)

1. A medicine supply apparatus comprising:

a tablet case containing medicines;

a roll of packing paper in the state where said packing paper is open at its upper end and folded at its lower end;

a mechanism for continuously drawing out said packing paper from said roll;

a nozzle having a discharge end that is inserted into said upper open end of said packing paper for projecting the medicines discharged from said tablet case into said packing paper upper open end; heat seal means for sealing by heat welding the part of an upper open end of said packing paper after having received the medicines from said nozzle, and partitioning said packing paper per pack; and

movable tension applying means urged toward said packing paper by an elastic member for applying tension to said packing paper at a location past the point where said nozzle discharge end is inserted into said packing paper upper open end and before the point where said heat seal means is located in a direction to close the upper end opening of said packing paper to be sealed by said heat seal means.

2. A medicine supply apparatus according to claim 1, wherein said tension applying means is fitted with the heat seal means.

Claims of Patent 7,228,988 ('988)

1. A medicine supply apparatus for supplying a medicine comprising:

a tablet case containing the medicine;

a nozzle for discharging the medicine from said tablet case; and a shutter rotatably provided in said nozzle for opening/closing a medicine drop path in said nozzle; wherein said shutter comprises

a first shutter plate of a size capable of closing the inside of said nozzle and that is rotated, a second shutter plate swingably connected to the tip of said first shutter plate, and a guide for swinging said second shutter plate in a direction opposite to a direction of rotation of said first shutter plate in a final stage where said first shutter plate is opened, and wherein the tip of said second shutter plate is located in a position to narrow an outlet of said medicine drop path when said first shutter plate is opened.

2. A medicine supply apparatus as claimed in claim 1 further comprising:

a roll of packing paper in the state where said packing paper is open at its upper end and folded at its lower end; wherein said nozzle projects the medicine discharged from said tablet case into said packing paper upper open end that is being continuously drawn out;

heat seal means for sealing by heat welding an upper end opening of said packing paper having received the medicines from said nozzle, and partitioning said packing paper per pack; and

tension applying means for applying tension to said packing paper in a direction to close the upper end opening of said packing paper to be sealed by said heat seal means.

3. A medicine supply apparatus according to claim 2, wherein said tension applying means is movably provided and urged toward said packing paper by an elastic member.

The "same invention" double patenting rejection is discussed at MPEP §804 II. A. Pages 800-19, 20. The following appears:

"A. Statutory Double Patenting - 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention.

Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet." (emphasis added)

A comparison of the claims of the two patents and of the application clearly demonstrates that the same subject matter is not being claimed. The application claims contain the following limitations that are clearly not present in the claims of either of the two patents:

1. *wrapping paper wound in a roll disposed on an attaching plate to wrap the medicine discharged from the tablet case.* Both '944 claim 1 and '988 claim 2 call for the packing paper to be open at its upper end and folded at its lower end.

2. *an operation section having a base from which a rod extends for engaging and depressing the wrapping paper* There is no corresponding limitation in either of the patents.

3. *a roller mounted on said base* There is no corresponding limitation in either of the patents.

4. *a rail on the attaching plate with the rail being inclined to the vertical direction and on which the roller is rotatably slidably engaged* There is no corresponding limitation in either of the patents.

5. *wherein said operation section is upward and downward movable as said roller rolls on said rail with said rod engaging and applying tension to the pulled-out wrapping paper by the weight of said operating section.* There is no corresponding limitation in either of the patents.

The five points presented above clearly show that the same invention is not being claimed.

We next apply the test of *In Re Vogel*, of whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. As demonstrated

below, the claims of the two patents contain limitations that are not present in the claims of the application.

1. Both '944 claim 1 and '988 claim 2 call for the packing paper to be open at its upper end and folded and its lower end. There is no corresponding limitation in the application claims. That is, there would be no literal infringement of the application claims which has no similar feature regarding the folding of the paper.

2. '944 has the following limitations (emphasized by underlining) in claim 1

a. a mechanism for continuously drawing out said packing paper from said roll;

b. a nozzle having a discharge end that is inserted into said upper open end of said packing paper for projecting the medicines discharged from said tablet case into said packing paper upper open end;

c. heat seal means for sealing by heat welding the part of an upper open end of said packing paper after having received the medicines from said nozzle, and partitioning said packing paper per pack; and

d. movable tension applying means urged toward said packing paper by an elastic member for applying tension to said packing paper at a location past the point where said nozzle discharge end is inserted into said packing paper upper open end and before the point where said heat seal means is located in a direction to close the upper end opening of said packing paper to be sealed by said heat seal means.

Clearly, the subject matter of the application claims could be made without infringing the claims of the '944 patent which has many limitations that are not necessary for the invention of the application claims. The test of MPEP 804, i.e.,

“Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.”

has been met.

3. ‘988 has the following limitations (emphasized by underlining) in claim 1

- a. a nozzle for discharging the medicine from said tablet case;
- b. a shutter rotatably provided in said nozzle for opening/closing a medicine drop path in said nozzle;
- c. wherein said shutter comprises
 - a first shutter plate of a size capable of closing the inside of said nozzle and that is rotated,
 - a second shutter plate swingably connected to the tip of said first shutter plate,
 - d. and a guide for swinging said second shutter plate in a direction opposite to a direction of rotation of said first shutter plate in a final stage where said first shutter plate is opened,
 - e. and wherein the tip of said second shutter plate is located in a position to narrow an outlet of said medicine drop path when said first shutter plate is opened.

Clearly, the subject matter of the application claims could be made without infringing the claims of the ‘988 patent which has many limitations that are not necessary for the invention of the application claims. The test of MPEP 804, i.e.,

“Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. “

again has been met.

The examiner bases his rejection on the theory that the “944 and ‘988 patents refer to “movable tension applying means” and/or “tension applying means”. He gives no weight to the other limitations of the patent claims and those of the application claims, which clearly show that there are different inventions for the reasons discussed above. For the consideration of the examiner, the “tension applying means” of the claims of both of the patents refer to the movable member 143 and plate attaching spring 144 shown in Figures 14 – 19 of the two patents. In the application claims, the tension applying mechanism that is described is that of element 113 of Figure 7. This mechanism is located in a position where the rolled wrapping paper is pulled out and not after the nozzle, as is required in the two patents. That is, the claims of the patents are directed to a type of tension applying mechanism used at one location in the apparatus and the claims of the application to another type of mechanism used at another location.

Basing the rejection on the broad recitation of the “tension applying means” in the claims of the two patents is not correct. As demonstrated above, the claims of the patents and those of the application are really directed to different mechanisms.

Applicant respectfully submits that it has demonstrated beyond a reasonable doubt that there is no basis to support a “same invention” type of double patenting rejection. Therefore, it is respectfully requested that the rejection be withdrawn and that the application promptly be passed to issue.

CONCLUSION

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

The Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this submission or to credit any overpayment, to Deposit Account No. 04-0100.

Dated: December 9, 2009

Respectfully submitted,

By 

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